In the

Supreme Court of the United States.

OCTOBER TERM, 1945.

No. 297.

RUSSELL BOX COMPANY, PETITIONER,

v.

GRANT PAPER BOX COMPANY, RESPONDENT.

REPLY BRIEF FOR PETITIONER.

Respondent objects to the grant of the writ chiefly on three grounds: (1) that the case involves only questions of fact; (2) that there is no conflict of law either with the decisions of this Court or with other Circuit Courts of Appeals; and (3) that no question of public importance is involved.

The issue is not, as respondent asserts, merely one of fact, and the question raised is not primarily whether Dreymann exercised more ingenuity than the man skilled in the art. The important questions, which require a conclusive answer by the Court, are:

1. Is a substitution of one material for another "of itself" without more, a patentable invention as a matter of law?

2. Is a combination of elements patentable when the combination is new only in the sense that it has been improved by substituting a better material for a poorer one?

Respondent's brief also raises the question—to what extent is invention a question of law or one of fact.

On the answers to these questions hang the right of the public to benefit from the development of new materials; and, more particularly, the right of the public to use an

article of commerce (amorphous petroleum wax) for a particular purpose without the imposition of a private tax on its use.

Although respondent's brief is full of charges of "misleading" mis-statements of fact, avoidance of issues and the alleged fictiousness of the conflict of decision, respondent nowhere contradicts petitioner's statements. Respondent only adds certain subordinate "facts" and relies on Dreymann's ignorance of commercial waxes to show that he used more than the skill of his calling and solved a problem. *Nothing said by respondent in magnifying the effort required or results achieved, overcomes the obvious truth that all that Dreymann did was to stick together two pieces of paper with a different kind of known wax.*

The following are thought to be the fundamental errors of respondent's brief.

1. Respondent mistakenly assumes that patentable invention is always a pure question of fact, whereas it is a mixed question of fact and law.

It is for this Court, in construing the Constitution and the patent statutes, to declare as a matter of law what constitutes *patentable* invention. The evaluation of conflicting testimony and the subordinate facts is for the trier of fact, but the trier of fact must be guided by the legal rules as to what may and what may not be patented. This Court made a clear statement that patentable invention is a question of law in *Mahn* v. *Harwood,* 112 U.S. 354, 358. Nothing said in the majority opinion in *Goodyear* v. *Ray O Vac,* 321 U.S. 275 contradicts this view.* Courts often say that invention

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* Compare the decisions by the First Circuit Court of Appeals in *Hanovia* v. *Butterick,* 127 F. (2d) 888, and *Lincoln Stores Inc.* v. *Nashua Mfg. Co.* 70 U.S.P.Q. 254, (not yet reported elsewhere) in which the court first said that invention was a mixed question of law and fact and then, in view of *Goodyear* v. *Ray O Vac,* refused to follow *Mahn* v. *Harwood.*

is a question of fact because the question actually raised depends on disputed facts rather than on the question of what may legally amount to invention under the statute. The question here, as to whether or not substitution *per se* is patentable, is solely a question of law.

2. Respondent says in effect (p. 3) that there is no conflict of opinion because the facts of the cases which are said to conflict are not the same.

This is wrong because in each of the conflicting cases the state of facts was essentially the same but the cases were decided by the application of different rules of law. There is no conflict over the rule of law that "mere" substitution is unpatentable; but there is a conflict over what is legally "mere" substitution.

In each of the decided cases referred to on pages 14–18 of the petition, the alleged invention was a change in the material of one element of an old combination.

Respondent attempts to reconcile the cited decisions. It says sisal for cotton[1], crepe paper for plain paper[2], iron for wood[3], paper for tin[4] are all mere obvious substitutions but on the other hand it says that glass for metal[5], and aluminum alloy for iron[6] are "something more than mere substitutions". Respondent says the last was a revolutionary suggestion. (Brief, page 13).

In each of these cases the change of material had pro-

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[1] *Fowler* v. *Honorbilt Products,* 131 F2 153 (CCA 3).

[2] *Angier* v. *Nehring Elec. Works,* 45 F2 354 (CCA 7).

[3] *Hotchkiss* v. *Greenwood,* 11 How. 248.

[4] *Lafferty Mfg. Co.* v. *Acme Ry. Signal & Mfg. Co.,* 138 F 729 (CCA 7).

[5] *Smokador Mfg. Co.* v. *Tubular Products Co.,* 31 F2 255 (CCA 2).

[6] *United Shoe* v. *E. H. Ferree Co.,* 64 F2 101 (CCA 2).

duced important benefits to the public and had been adopted by it and by the defendant. In each case the question for decision was: Did it, of itself, amount to invention to substitute the better material for the poorer in the otherwise old combination. Yet in the first three cases the courts held that the change did not amount to invention, while in the last three cases the courts reached the opposite conclusion. This difference in conclusion has arisen, not because the facts of the cases were different, but because the courts have differed as to the rule of law to be applied. That some of the Circuits have not always been consistent in their rulings only emphasizes the confusion which exists as to the applicable rule of law.[1]

The rule of the First and Second Circuits is stated in the Ferree case in the following words:

> ". . . it can amount to invention if some *new and useful result or increase of efficiency and decided saving* in the operation is clearly obtained". (*United Shoe Machinery Corp.* v. *E. H. Ferree,* 64 F. (2d) 101–103),

while the rule of the Third and Seventh Circuits is stated in the Fowler case as follows:

> ". . . it is not invention to substitute superior for inferior material . . . even in cases where the substitution was both new and useful and the increase in utility exceedingly great. . . . But in order for the substitution of material to rise to the dignity of invention the substitution must produce a *new mode of operation or result in a new function or property.*" 131 F. (2d) 153.

Obviously the guiding legal principles adopted by the Third and Seventh Circuits are not the same as those of the

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[1] The decisions in the Third Circuit are not consistent. The rule in that Circuit has changed. *Compare Fowler* v. *Honorbilt,* 131 F (2d) 153, with the earlier decision in *Allen Filter Co.* v. *Star Metal Co.,* 40 F (2d) 252.

First and Second, and there is a conflict of decision which makes the outcome of each case depend on the forum and not on the facts.

Which of the two rules of law is the correct one?

We submit that this Court should resolve this conflict.

3. Respondent asserts that Dreymann made a new combination of elements when in fact he repatented an old one.

To petitioner's statement that paper laminated with wax is an old combination, respondent replied that paper laminated with a *particular* wax is a new combination. If respondent is correct, then Gulborg[1] produced "a new" combination when he improved the fitting in the old combination of pump, connecting conduit, coupler and fitting. In that case this Court declared the patent invalid. The fallacy in respondent's argument is evident. Like Gulborg, Dreymann has repatented an old combination even if he contributed a specific improvement in one of its elements. At most he taught only the addition of a foreign colloid to wax. Now he seeks to prevent the use of old commercial waxes containing natural colloids. Such a monopoly is greater than any contribution to the art which Dreymann may have made and is offensive to the spirit of the Constitutional provision which was intended to further the progress of science and the useful arts.

4. Respondent argues that Dreymann made a new contrivance because of a "new relationship of elements", and that the result was different in kind. The argument is unsound.

Feitsch (patent No. 1,269,918, Rec. p. 456) made a laminated container wall for cracker cartons from two pieces of paper stuck together with oxidized petroleum residuum.[2]

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[1] *Bassick* v. *Hollingshead*, 298 U.S. 415–426.

[2] This residuum is either asphalt or wax according to the crude petroleum base from which it is made. R. 272.

Fietsch said that his wall was thin, flexible and moisture-proof, and could be printed on (R. 458, lines 20–36). Dreymann, the patentee in the case at bar, stuck together two pieces of paper with amorphous petroleum wax to which he had added a colloid. The only difference between Fietsch's and Dreymann's container walls lay in the material used to stick the pieces of paper together. If there was a difference in result, it was only in the degree of flexibility and moisture-proofness. Such differences are differences in degree, not in kind.

Dreymann modified his wax by adding a foreign colloid, not realizing that there were commercially available amorphous petroleum waxes, the use of which is now charged to infringe, which contained naturally a sufficient amount of resinous colloid to give him the results he was seeking. Respondent argues that the addition of colloid made a "new relationship of elements or a new contrivance". This is not so because the relationship of adhesive (wax or asphalt) and paper was old, having been described by Fietsch. There was no new interaction between the wax and the paper. Any difference was due to the known inherent qualities of the wax. Accordingly, we submit that Dreymann's product was not different in kind within the meaning of this Court in *Smith* v. *Goodyear*. Dr. Cummings' dental plate was different in kind because the process of vulcanization made the plate and the inserted teeth a unitary structure. If Dreymann's laminated wall is better in kind because of the substituted wax, then the cushion of the Fowler case and the torpedo of the Lafferty case were likewise different in kind from the structures of the prior art.

The Public Importance of this Case.

This is not the ordinary patent case in which the consequences of the decision are of importance only to the parties for two reasons:

1. The decision results in the imposition of a tax on a staple article of commerce used for protecting foods. Drey-

mann was not the first to teach the public to use containers made of paper and wax for preserving foods, but he seeks as great a reward as though he were. Hundreds of box manufacturers throughout the country will be required to pay tribute to Dreymann for the privilege of making Fietsch's old container with the use of ordinary commercial amorphous petroleum wax. Though Dreymann only taught the *addition* of more colloid, he will get a monopoly on a substantial section of the food-box industry.

2. The great benefits of research in providing almost numberless substitutes should not be kept from the public at large and diverted "into the laterals of monopoly".

The questions raised by this case are of even greater importance to the public today than they were when this Court granted certiorari in the Ferree case which raised the same questions.[1] The rules relating to substitution of materials have not been restated by this Court for seventy years but at that time materials were fewer in number and knowledge of the natural properties of materials was less. Today, due to diligent research, we know vastly more about natural things and have synthesized things undreamed of even twenty years ago. *The law as to substitution of materials has developed a new importance to the people.*

The exclusive right to use materials for particular purposes should not be handed over to individuals except in cases where invention is clear. Accordingly, we again urge that, if a patent may be granted each time that one material replaces another with better results, the "progress of science and useful arts" will be hampered, and not "promoted" as provided by the Constitution.

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[1] "2. Whether the substitution of one old material for another old material is invention in cases where the improvement claimed is attributable only to the well-known properties inherent in the material, and not to the combination or interaction of the part with other parts and where the improvement is the result of judgment and skill in the selection of the particular material?" (Ferree petition, p. 4).

We submit that the questions raised by the case at bar should now be decided[1], and that the rules of law as to substitution of materials be stated once and for all so that unjustifiable monopolies shall not continue to levy tribute on the public.

Respectfully submitted,

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BOSTON, MASS., September 10, 1946.

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[1] The need of a clear cut statement on the questions of law raised by the case at bar is emphasized by the decision of the Circuit Court of Appeals for the First Circuit on July 19, 1946, in *Lincoln Stores, Inc.* v. *Nashua Mfg. Co.*, 70 U.S.P.Q. 254 in which the majority of that court held that the substitution of staple rayon fibers for wool fibers in blankets was an invention, while Judge Woodbury dissented on the ground that the difference in result was only a difference in degree and not in kind.